

REMARKS

Claims 113-127, 130, 132-137, 140-160 and 163-164 are pending in the application.

Applicants note that the Examiner correctly noted that there were two appearances of claim 129 (one as “canceled” and the other as pending). Applicants note that claim 129 was canceled in the Response filed November 11, 2007. However, the Office Action of January 24, 2008 lists it as still pending due to the erroneous listing in the Response. Applicants herein request cancellation of claim 129 and have deleted its text from the Listing of the Claims. Applicants respectfully submit that the Listing of the Claims is now compliant.

Claim 117 has been amended, as helpfully suggested by the Examiner, to delete the first occurrence of “of” in “selected from the group of consisting of.” No new matter is added by the amendment.

Claims 151, 163 and 164 have been amended to specify that the elements are operably linked in *cis* to the linked element and that the promoter is upstream of the desired product. Support for the amendment may be found in the Specification at page 18 lines 1-7. The Applicants have also added the step of recovering the desired product from the cells. Support for this amendment is found throughout the Specification, for example at page 5, lines 21-23. Thus, no new matter is added.

Applicants note with appreciation the withdrawal of the rejection of claims 112, 143-146, and 161-162 under 35 U.S.C. § 102(b), or in the alternative under 35 U.S.C. § 103(a) over U.S. Patent No. 6,235,967 to Tan *et al.*

Objection under 37 CFR § 1.75(c)

The Office Action objects to claims 152-160 under 37 CFR § 1.75(c) as allegedly presenting improper forms of multiple dependent claims. Applicants herein amend claim 152 to recite the components of the vector as set forth in claim 115 rather than to refer to claim 115. No change in claim scope is presented and no new matter is added. Thus, Claim 152 now is only dependent on claim 151 and claims 152-160 no longer present an issue under 37 CFR 1.75(c). Withdrawal of the objection is respectfully requested.

35 U.S.C. § 102(b)

The Office Action rejected claims 151, 163 and 164 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 6,235,967 to Tan et al. (“Tan”).

Applicants have amended claims 151, 163 and 164 to include the feature that the elements of the vector are positioned in *cis* and therefore, exert the modulatory effects in *cis*. Thus, the previous Examiner’s concern regarding the broad interpretation of the term “operably linked” is moot.

Turning to the rejection over Tan, Tan describes the expression of a therapeutic protein as a means of delivering a therapeutic protein to cancerous cells in conjunction with diagnosis of metastasis (Col. 5, lines 7-12). Tan does not disclose a method for producing a desired protein from cells as a means of recovering a desired protein from production cells as instantly claimed.

Applicants earnestly submit that claims 151, 163 and 164, as amended are not anticipated by Tan and respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

Double Patenting

Applicants respectfully request that the Examiner hold the provisional double patenting rejection in abeyance until indication that the instant claims are allowable.

SUMMARY

Applicants believe that this application is now in condition for allowance and respectfully requests that the outstanding rejections be withdrawn and this case passed to issuance. The Examiner is invited to contact the undersigned at (650) 467-3618 in order to expedite the resolution of any remaining issues.

In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our **Deposit Account 07-0630** for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Respectfully submitted,

GENENTECH, INC.

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